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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/678,646

10/06/2003

Timothy L. Robinson

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08/04/2011

Williams Mullen

222 Central Park Avenue

Suite 1700

Virginia Beach, VA 23462

EXAMINER

VANDERHORST, MARIA VICTORIA

ART UNIT

PAPER NUMBER

3688

NOTIFICATION DATE

DELIVERY MODE

08/04/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip@williamsmullen.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/678,646	<b>Applicant(s)</b> ROBINSON ET AL.	
	<b>Examiner</b> VICTORIA VANDERHORST	<b>Art Unit</b> 3688	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33,35-53,58 and 60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33,35-53,58 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

This communication is in response to the amendment filed on 05/17/2011 for the application No. 10/678,646. Claims 1-32 have been previously withdrawn. Claims 34, 54-57, 59 and 66-69 have been previously cancelled. Claims 33, 35-53, 58 and 60 are currently pending and have been examined. Claims 33, 35-53, 58 and 60 have been rejected as follow.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 33-34, 40-53, and 54-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,256,737 (Bianco et al) in view of US. Pg. Pub No. 2003/0130954 (Carr).**

3. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight is given to claim language that is for intended use as noted in each claim.

**As to claim 33**, Bianco discloses a method for enabling a user to use a biometric system, comprising:

receiving, at a first system access at a first computing device at a first enrollment station, first enrollment data for a user

(See at least Fig. 1, element 106, and Col. 2: 53-67 and Col. 3:1-17. Further in Col. 29, Bianco elaborates in a biometric policy comprising a plurality of devices, "...a user is not authenticated until he or she passes a biometric policy 504...", Col. 29:60-67 and Col. 30:1-3. In addition, Bianco discloses layering devices in a policy, Col. 30:4-35);

storing, in a system user record in a system database, the first enrollment data

(Bianco's solution comprises biometric templates analogous to "system user record", see at least Fig. 5, element 502, Col. 17:38-48);

receiving, at a time asynchronous with the first system access at a second system access at a second computing device at a second enrollment station, a portion of the first enrollment data and second enrollment data for the user

(Bianco's solution teaches the type of devices that the user needs to be enrolled, see at least Fig. 6, element 618.

Further, Bianco teaches, "...the types of devices the user needs to be enrolled in are determined by looking at the biometric policy 504 assigned to the user's biometric group 506...", Col. 19: 24-40.

Furthermore, "...one or more unique biometric template 502 is created and stored in biometric server 104 each time a user enrolls on a different biometric device...", Col. 17:38-48),

wherein the portion of the first enrollment data is used to locate the system user record and wherein the second enrollment data differs from the first enrollment

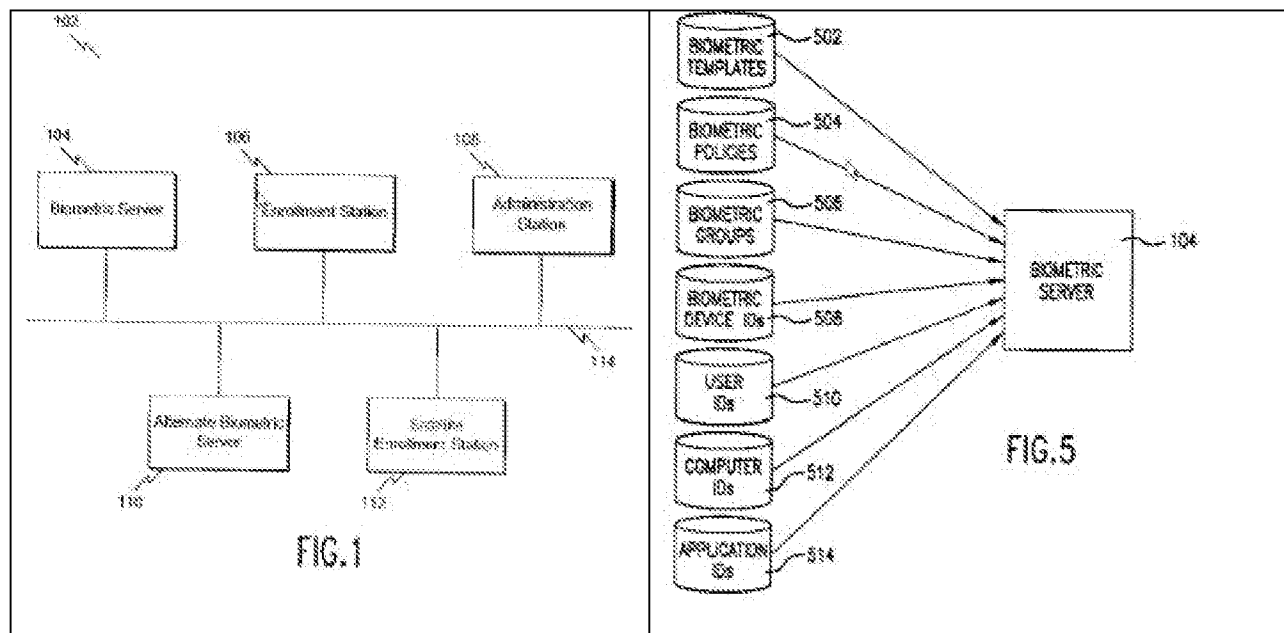
(Bianco elaborates in the list of policies and/or devices that are used to execute the particular biometric policy, see at least Col.17: 49-67 and Col. 18:1-7.

Next, Bianco teaches, "...Once it is known which biometric policy 504 will be applied, a biometric template 502 is created for each biometric device 508 associated with the biometric policy 504 by enrolling the user in each device.

This is shown in step 620. Alternatively, a biometric template 502 can be created for each biometric device within network system 202. Finally, in step 622, each computer ID 512, biometric device ID 508, biometric group 506, biometric policy 504, user ID 510, biometric template 502 and application ID 514 is stored in biometric server 104...", Col. 19:24-40.

The Examiner notes that Bianco's solution comprises a biometric policy 504, which contains the number of devices that the user needs to enroll because the execution of the biometric policy involves the use of on or more biometric templates, Col. 2:53-66, Col. 17:49-67 and Col. 18:1-8, Fig. 5.

Furthermore, Bianco's solution comprises different enrollment stations, Col. 10:1-27 and different devices with different templates required by the system to authenticate an user, Col. 2:53-66);



storing, in the system user record in the system database, the second enrollment data (Bianco teaches, "...one or more unique biometric template 502 is created and stored in biometric server 104 each time a user enrolls on a different biometric device...", Col. 17:38-48), and identifying, at the system database, whether the first enrollment data and the second enrollment data together comprise complete enrollment data, wherein the complete enrollment data is received during a plurality of asynchronous system accesses and enables the system user record for use in biometrically authenticating the user.

(Bianco elaborates that his system **requires complete enrollment data before authenticate the user**, in Bianco's system the user needs to pass the biometric policy, "...it is the biometric policies 504 of the present invention that determine the method or way in which a user is to be authenticated by biometric server 104

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(FIG. 1). It is important to note that **a user is not authenticated until he or she passes a biometric policy 504....**”, Col. 29:60-67 and Col. 30:1-3.

Next, Bianco elaborates on the list of devices the user needs to enroll to complete to complete his/her biometric profile, Col. 28:13-28, Fig. 13B item 1328. Furthermore, Bianco’s biometric policy 504, contains the number of devices that the user needs to enroll because the execution of the biometric policy involves the use of on or more biometric templates, Col. 2:53-66, Col. 17:49-67 and Col. 18:1-8, Fig. 5.

Further, Bianco discloses receiving data during a plurality of asynchronous system accesses where the data is not complete enrolled until the user enrolls in the last device, (Fig. 13B, elements 1328, 1330 and 1332)

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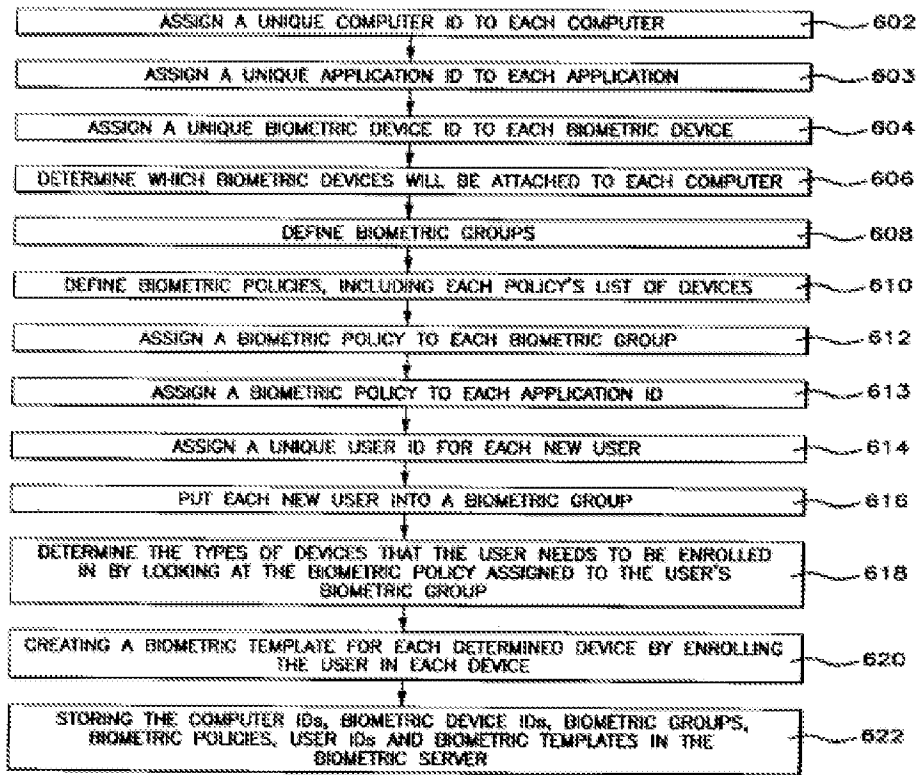


FIG. 6

(Bianco teaches different type of devices that the user needs to enroll, each device has a different biometric template, fig 6, elements 618 and 620. Further, Bianco's method uses scores to test the user in the different biometric devices, if the user passes a threshold police then the user is authenticated, Col. 35:53-67 and Col. 36:1-11).

**But**, Bianco does not expressly disclose identifying the system user record as active.

However, Carr discloses a system that when establishes a record, sets a flag indicator to "active" value (paragraph 0044).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Carr's teaching into the system of Bianco. One



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would be motivated to render data that reflects the status of user's record, in order to reflect a robust biometric system.

**Note:** As for the limitation "wherein the complete enrollment data is received during a plurality of asynchronous system accesses...for use in ...", the feature "the complete enrollment data is received during a plurality of asynchronous system accesses" is not positively recited in the method step and does not impact the manipulative step/function of "identifying, at the system database, the system user record as active". In other words, regardless of how the enrollment data is received or how it is used, the step "identifying, at the system database, the system user record as active" will not be changed.

**As to claims 40 and 41**, Bianco and Carr disclose the method of claim 33, and further Bianco discloses wherein one or more of the first enrollment station and the second enrollment station

(The Examiner notes that Bianco's solution comprises a biometric policy 504, which contains the number of devices that the user needs to enroll. Furthermore, Bianco's solution comprises different enrollment stations, Col. 10:1-27.

Also, the Examiner notices that Bianco's solution comprises a biometric server which contains biometric policies to authenticate users. "...each pre-defined biometric policy 504 has a list of devices associated to it...", See at least Col. 17:49-67 and Col. 18:1-8, Fig. 5)

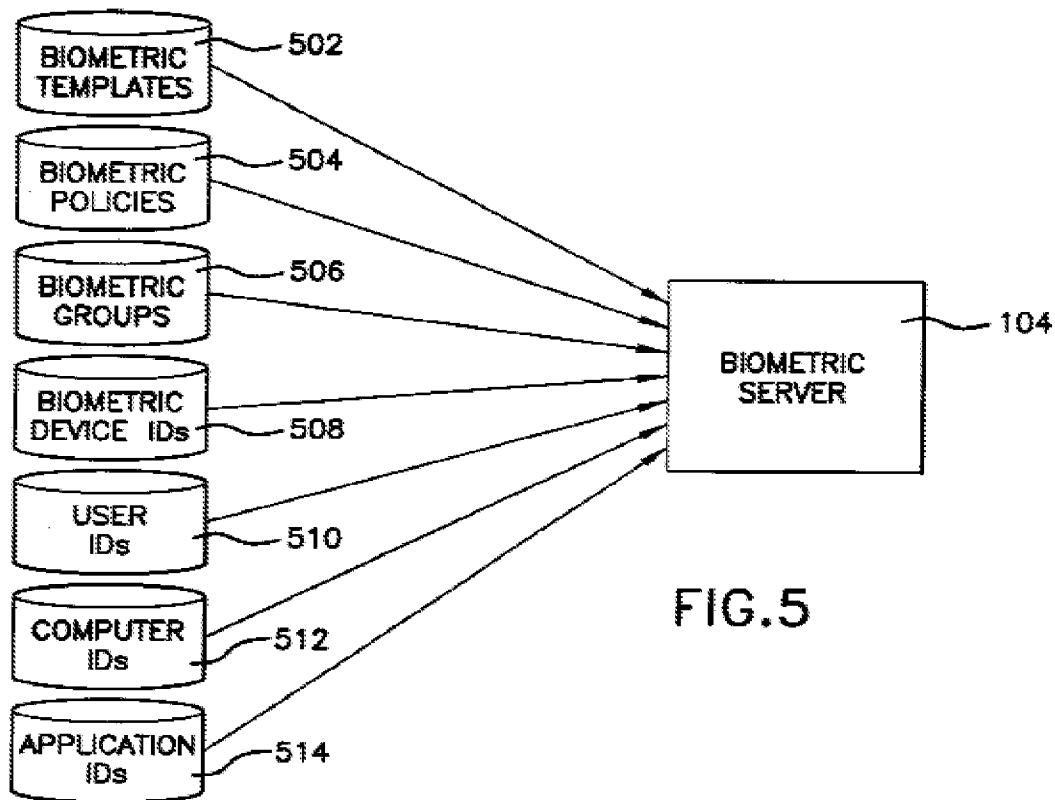


FIG.5

The second enrollment station includes a record output device for outputting one or more system access records and, wherein each of the records are is configured as one or more of a printed report, a media output to an electronic device and an email (Col. 10:14-48).

Further, Bianco discloses the user is asked to give biometric measurements a few different times (Col. 27:1-2 and Col. 28:1-12). The Examiner notes that it is inherent that if Bianco's solution comprises a database system, it has a timestamp feature in place to store the date and the time and the identification of each transaction that access the database records.

**As to claim 42**, Bianco and Carr disclose the method of claim 33, and further Bianco discloses

displaying, at one or more of the first enrollment station, and the second enrollment station, one or more portions of system user enrollment data stored at said system database

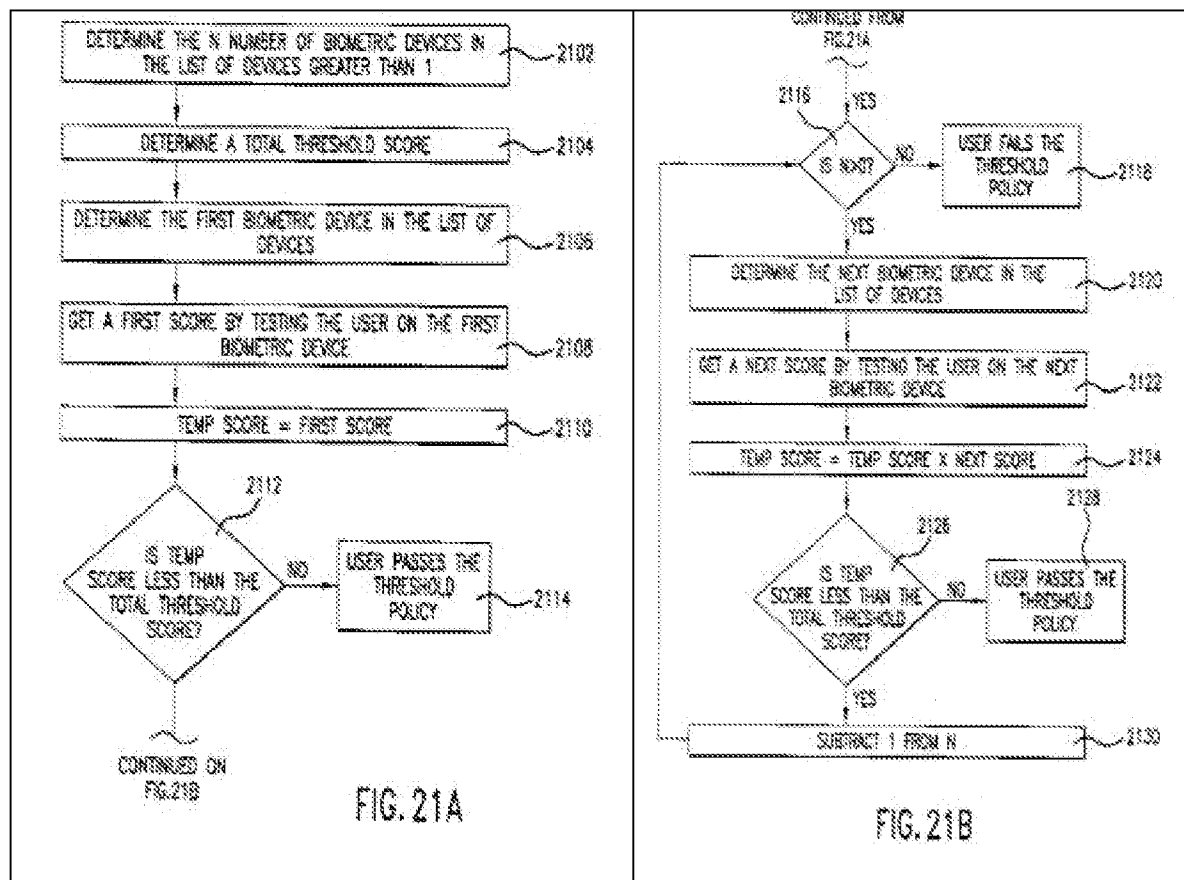
(in Bianco's system the user is requested to provide multiple fingerprint measurements, Col. 27:1-2 and Col. 28:1-12. Further, Bianco's system comprises different types of devices with a determined biometric template for each device);

prompting the system user to confirm the displayed data (Bianco's solution has biometric policies, Col. 29:60-67 and Col. 30:1-3);

receiving confirmation of the displayed data from and storing, at said system database, the confirmation (Col. 30:15-30).

**As to claim 43**, Bianco and Carr disclose the method of claim 42, and further Bianco discloses further comprising enabling the user to present corrected data (The threshold policy in Bianco's solution allows flexibility, correction, to the level of protection to pass the authentication process, Col. 3:18-32, Fig. 31).

**As to claim 44** , Bianco and Carr disclose the method of claim 33, and further Bianco discloses comprising receiving verification of one or more portions of the complete enrollment data from a system operator (Fig. 21A , 21B and Figs. 31).



As to claim 45, Bianco and Carr disclose the method of claims 44, and further Bianco discloses verifying portions of the complete enrollment data (Bianco discloses an enrollment station, Fig. 1, element 106).

But Bianco does not disclose offering said system operator one or more incentives

However, Carr discloses a mailing system that employs biometric data to identify a sender and offers postage discounts (§§ 0044 and 0053)

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Carr's teaching into the system of Bianco. One would be motivated to provide some stimulus via regular mail to gather user data.

**As to claims 46 and 58**, Bianco and Carr disclose the method of claims 44 and 54, and further Bianco discloses comprising comparing system operator data with data stored at said system database ( Bianco discloses a biometric server, 104 and an enrollment station, 106. "...The types of data stored in biometric server 104 are partially determined through the operations of enrollment station 106 and administration station 108. Enrollment station 106 is used to enroll users into biometric system 102. Enrollment station 106 has attached to it every type of biometric device used by biometric system 102 to enroll and ultimately authenticate users...", Col. 10:1-27).

**As to claims 47**, Bianco and Carr disclose the method of claims 44, and further Bianco discloses wherein the system operator is remote from one or more of the first enrollment station and the second enrollment station

(Fig. 2, Elements 106, enrollment station and element 208, user computer.

Further, The Examiner interprets each of the Biometric devices as an "enrollment station", since the devices are hardware and each of biometric devices 508 is associated with a biometric template 502, "...Enrollment station 106 is used to enroll users into biometric system 102. Enrollment station 106 has attached to it

every type of biometric device used by biometric system 102 to enroll and ultimately authenticate users...", Col. 10:1-14).

**As to claim 48**, Bianco and Carr disclose the method of claim 44 and 54, and further Bianco discloses wherein the verification includes a biometric sample received from the system user (Bianco teaches, "...First, a user is prompted for multiple samples of a fingerprint. For each sample, a number of characteristics or measurements are identified. Then, for all of the multiple samples, a number of common characteristics or measurements are identified...", Col. 8: 41-54).

**As to claim 49**, Bianco and Carr disclose the method of claim 44, and further Bianco discloses storing the verification in the system user record ( Bianco teaches, "... The device open interface is propriety software that is used to communicate to biometric devices in order to retrieve live sample data, match live sample data against stored data (i.e., biometric templates)...", Col. 14:9-19)

**As to claim 50**, Bianco and Carr disclose the method of claim 33, and further Bianco discloses wherein the first enrollment data and the second enrollment data comprises one or more biometric records (Bianco teaches, "...In FIG. 5, biometric server 104 (FIG. 1) stores collections of biometric templates 502, biometric policies 504, biometric groups 506, biometric device IDs 508, user IDs 510, computer IDs 512 and application IDs 514...", Col. 17:38-48).

**As to claim 51**, Bianco and Carr disclose the method of claim 33, and further Bianco discloses wherein said system database is located at one or more of the first enrollment station and the second enrollment station (Col. 14:25-32).

**As to claim 52**, Bianco and Carr disclose the method of claim 33, and further Bianco discloses comprising verifying, by one or more third parties or third party databases, the data stored at said system database (Col. 56:1-27).

**As to claim 53**, Bianco and Carr disclose the method of claim 33, and further Bianco discloses comprising sending an identification number to authenticate a sending device (Bianco discloses "...biometric device IDs, user IDs", Col. 2:53-64).

**As to claim 60**, Bianco and Carr disclose the method of claim 33, and further Bianco discloses wherein said system database includes a plurality of system databases (Col. 16:64-66 and Col. 17:1-10).

**4. Claims 35-38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,256,737 (Bianco et al) in view of US. Pg. Pub No. 2003/0130954 (Carr) and in view of US Patent No. 7,630,986 (Herz et al).**

**As to claims 35-38**, Bianco and Carr disclose the method of claim 33, but Bianco does not disclose comprising:

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prompting a user to select at least one incentive from a plurality of incentives wherein the plurality of incentives includes one or more of an item, a service, a gift certificate, a coupon, a discount, and money.

rendering said at least one incentive by one or more of a direct rendering of said incentive, a paper-based promise of said incentive and an electronic-based promise of said incentive.

automatically dispensing said at least one incentive.

However, Herz discloses a user identifier used in biometrics via a credit card and provide promotional offers and coupons. The incentive is provided in automatic way for example at a kiosk using a biometric ID (Col 54:3-15 and Col. 151:29-39)

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Herz's teaching into the system of Bianco. One would be motivated to provide stimulus to gather user data in order to build a reliable and robust biometric database.

**As to claim 39**, Bianco, Carr and Herz disclose the method of claim 33, but Bianco does not disclose further comprising sending said at least one incentive via a parcel delivery network.

However, Carr discloses a mailing system that employs biometric data to identify a sender and offers postage discounts (paragraphs 0044 and 0053)



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Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Carr's teaching into the system of Bianco. One would be motivated to provide stimulus via regular mail to gather user data.

### ***Response to Arguments***

4. Applicant's arguments of 05/17/2011 have been very carefully considered but are not persuasive.

5. Applicants argue

Bianco's biometric policy does not specify each of the devices of the instant claim. The fact that Bianco discloses the use of one or more biometric templates does not equate to each of the devices and data of the instant claim

The Examiner respectfully disagrees with the argument from the Applicant because in Fig. 3, Bianco discloses the computer system used in his solution.

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6. Applicants argue

Applicant has amended claim 33 as follows .... whether the first enrollment data and the second enrollment data together comprise the complete enrollment data, wherein the complete enrollment data is received during a plurality of asynchronous system accesses and enables the system user record for use in biometrically authenticating the user.

As can be seen the user is authenticated when the piecemeal enrollment results in the collection of the necessary data.

The Examiner respectfully disagrees with the argument from the Applicant because

Bianco elaborates that his system requires complete enrollment data before

authenticate the user. In Bianco's system it is important to note that a user is not

authenticated until he or she passes a biometric policy, Col. 29:60-67 and Col. 30:1-3.

Next, Bianco elaborates on the list of devices the user needs to enroll to complete his/her biometric profile, Col. 28:13-28, Fig. 13B item 1328.

Further, Bianco discloses receiving data during a plurality of asynchronous system accesses where the data is not completed (complete enrolled) until the user enrolls in the last device, (Fig. 13B, elements 1328, 1330 and 1332).

Furthermore, the limitation "the piecemeal enrollment results in the collection of the necessary data" is not in the claims.

In summary, the prima facie of obviousness has been established. Bianco's reference combined with Carr's reference discloses all the limitations on the claims. The Examiner respectfully notes that Applicant has not provided rebuttal evidence to overcome the prima facie case.

Further, the elements of this instant Application are old and well known at the time of the invention. The combination set for the rejection produce results that are predictable.

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Moreover, the Applicants argue features that are not required by the claims, failing to consider the breadth of the claims, therefore Applicants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

Applicants' amendment **necessitated** the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. VICTORIA VANDERHORST whose telephone

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number is (571)270-3604. The examiner can normally be reached on regular hours from 9-4 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571 272 6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. VICTORIA VANDERHORST/

Examiner, Art Unit 3688

Jul 25/2011

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3688